

REMARKS

I. STATUS OF CLAIMS

Claim 27 is currently pending. Claim 27 is amended to further clarify the description of the polycondensate (A). Support for such an amendment can be found in the as-filed specification, for example on page 4, ll. 10-17, page 6, ll. 27-28, and the Example. The amendment to claim 27, which defines the polycondensate (A) as not being hydrophilic, does not add new matter since it merely excises a portion of the invention, the full whole portion of which was described in the original specification. See, *In re Johnson*, 558 F.2d 1008, 194 U.S.P.Q. 187, 196 (CCPA 1977)("[h]ere, as we hold on the facts of this case, the 'written description' in the 1963 specification supported the claims in the absence of the limitation, and that specification, having described the whole, necessarily described the part remaining. The facts of the prosecution are properly presented and relied on, under these circumstances, to indicate that appellants are merely excising the invention of another, to which they are not entitled, and are not creating an 'artificial subgenus' or claiming 'new matter.'").

Moreover, one skilled in the art would understand from Applicant's description that the claimed polycondensate (A) would necessarily not be hydrophilic, which in itself supports the amendment. See *Union Oil of Cal. v. Atlantic Richfield Co.*, 208 F.3d 989, 997, 54 USPQ2d 1227, 1232-33 (Fed. Cir. 2000) (Description in terms of ranges of chemical properties which work in combination with ranges of other chemical properties to produce an automotive gasoline that reduces emissions was found to provide an adequate written description even though the exact chemical components of each combination were not disclosed and the specification did not disclose any distinct

embodiments corresponding to any claim at issue. "[T]he Patent Act and this court's case law require only sufficient description to show one of skill in the . . . art that the inventor possessed the claimed invention at the time of filing.").

See also *In re Wertheim*, 541 F.2d 257, 263-66, 191 U.S.P.Q. 90, 97-98 (C.C.P.A. 1976), which held that an applicant can amend a broad range to exclude values shown in the examples. In the present case, the Example does not describe the polycondensate (A) as being hydrophilic. Applicant has amended the claims to be consistent with this example. Thus, the specification clearly provides written description support for this amendment, and new matter has not been added by the amendment presented herein.

II. REJECTION UNDER 35 U.S.C. § 103

A. Bhatt in view of Ramin, Samain and Mougin

The Examiner maintains the rejection of claim 27, as unpatentable under 35 U.S.C. § 103(a) over U.S. Patent No. 6,106,808 to Bhatt et al. ("Bhatt") in view of U.S. Patent No. 5,683,681 to Ramin et al. ("Ramin"), WO 98/22077 (U.S. Patent No. 6,423,297 as equivalent) to Samain et al. ("Samain") and WO 97/25021 (U.S. Patent No. 6,395,265 as equivalent) to Mougin et al. ("Mougin"). Office Action at page 2. Applicant respectfully disagrees and traverses the rejections for the following reasons.

Bhatt teaches that the requisite carboxylated polyurethane resins are hydrophilic. See Bhatt at col. 4, ll. 1-5. In so doing, Bhatt distinguishes his invention from the prior art which he defines in the following way: "traditional hair setting resins are hydrophobic. In contrast, the carboxylated polyurethane resins are hydrophilic, yet provide good hair set retention, while imparting a soft, natural, and nontacky feel to treated hair." *Id.* at

col. 4, ll. 9-13. As Bhatt teaches that hydrophilic polyurethane resins are an improvement over non-hydrophilic hair resins, because they “are soluble in water and in a wide range of water-to-alcohol ratios, without the need to neutralize the resin with a base,” Bhatt actually teaches away from the presently claimed polyurethane. See Bhatt at col. 4, ll. 14-16.

For example, in amended claim 27, the at least one polycondensate (A) “is *not* hydrophilic.” *Id.* Thus, one of ordinary skill in the art would have been led away from adding a non-hydrophilic polyurethane to the composition of Bhatt. “A reference may be said to teach away when a person of ordinary skill, upon reading the reference, would be discouraged from following the path set out in the reference, or would be led in a direction divergent from the path that was taken by the applicant.” *In re Gurley*, 27 F.3d 551, 553, 31 USPQ2d 1130, 1131 (Fed. Cir. 1994).

For at least these reasons, there can be no motivation to modify the claimed invention in the manner asserted by the Examiner. The Examiner's attention is specifically directed to well-known Federal Circuit decisions holding that if a proposal for modifying the prior art in an effort to attain the claimed invention causes the art to become inoperable or destroys its intended function, then the requisite motivation to make the modification would not have existed. See, *In re Fritch*, 972 F.2d 1260, 1265-66, 23 U.S.P.Q.2d 1780, 1783 (Fed. Cir. 1992); *In re Ratti*, 270 F.2d 810, 813, 123 U.S.P.Q. 349, 352 (C.C.P.A. 1959) (holding the suggested combination of references improper under section 103 because it “would require a substantial reconstruction and redesign of the elements shown in [a prior art reference] as well as a

change in the basic principles under which [that reference's] construction was designed to operate.").

The Examiner proposes to modify Bhatt with Mougin, Samain, and Ramin, stating that:

A person of ordinary skill in the art would have been motivated to modify Bhatt's method by incorporating the copolymer disclosed by Mougin et al. and the anionic polymer disclosed by Samain et al. in the hair composition, or substituting the polyurethane with the copolymer and other film forming agent such as those disclosed by Ramin because the copolymers disclosed by Mougin et al, and as herein claimed, are known to provide superior properties as film forming agent of film forming additive for hair products and is particularly known to be useful in aerosol form.

Office Action at page 4. Applicant respectfully submits that Mougin, Samain, and Ramin do not cure the deficiencies of Bhatt.

In particular, Mougin teaches cosmetic compositions containing "at least one multiblock polycondensate whose chain consists of the repetition of at least one polysiloxane block and of at least one polyurethane and/or polyurea block . . . the said polycondensate being dissolved in an aqueous, organic or aqueous-organic solvent system." *Id.* at col. 3, ll. 5-12. Thus, Mougin teaches that its polycondensate can be dissolved in a broad range of solvents, including, for example, isododecane, a hydrophobic solvent. See Mougin at Example 4. Further, the polycondensate of Mougin can be neutralized in-part, or completely, as recited in claims 21 and 23, which is taught away from in Bhatt ("without the need to neutralize the resin with a base."). *Id.* at col. 4, ll. 14-16. Thus, one of ordinary skill in the art would have been led away from incorporating the polycondensate of Mougin into the compositions of Bhatt because

Bhatt teaches that hydrophilic polycondensates are an improvement over “traditional hair setting resins” taught in the art, such as the polycondensates taught in Mougin.

Moreover, if one of ordinary skill in the art were to substitute the polycondensate of Mougin with that of Bhatt, albeit against the express teachings of Bhatt to only include hydrophilic polyurethane resins, the combination would still not render instant claim 27 obvious. Again, Mougin teaches that its claimed polycondensate can be dissolved in any solvent, i.e., is not limited to be hydrophilic or hydrophobic. In contrast, the polycondensate currently claimed, is “not hydrophilic.” Therefore, not only would one of ordinary skill in the art have to go against the express teachings of Bhatt to incorporate the polycondensate of Mougin into its compositions, but would also have to the pick and choose among the teachings of Mougin to render instant claim 27 obvious.

The addition of Ramin to the combination of Bhatt and Mougin does not remedy the apparent deficiencies described above. When viewed as a whole, Ramin does not teach the requisite film-forming polymers, but instead teaches nail compositions that comprise a dispersion of water-insoluble polymers and a plasticizer. See Ramin Abstract and col. 1, ll. 35-45. Accordingly, one of ordinary skill in the art would not have been motivated to add, or substitute the water-insoluble polymers of Ramin to the composition of Bhatt, because Bhatt expressly teaches that its compositions contain hydrophilic polyurethanes. For at least these reasons, the combination of Bhatt, Mougin and Ramin does not render instant claim 27 obvious.

Samain fails to render the deficiencies of Bhatt, Mougin, and Ramin. Samain is directed to an aerosol device containing an aerosol composition comprising anionic film-forming polymers. See Abstract. However, Ramin fails to teach the at least one

polycondensate presently claimed. As such, the Examiner failed to establish a prima facie case of obviousness over the combination of Bhatt, Mougin, Ramin, and Samain. Accordingly, Applicant respectfully requests the rejection be withdrawn.

B. Mougin in view of Samain, Bhatt and Malawer

Claim 27 is further rejected under 35 U.S.C. § 103(a) as unpatentable over the combination of Mougin and Samain in further view of Bhatt and U.S. Patent No. 5,458,871 to Malawer et al. ("Malawer"). Office Action at page 5. In view of the discussion above, Applicant respectfully submits that the combination of Mougin in view of Samain and Bhatt fails to render instant claim 27 as obvious, and that Malawer fails to remedy their deficiencies.

As discussed above, Mougin broadly teaches that its claimed polycondensate can be dissolved in any solvent, including aqueous, organic and aqueous-organic solvent systems. See Mougin at col. 3, ll. 10-13. Malawer does not remedy this deficiency of Mougin. Malawer teaches hair spray compositions that are microemulsions of water-insoluble polymers, a surfactant and predominantly water. See Malawer at col. 2 at ll. 20-35. Thus, Malawer neither teaches nor suggests, using a combination of a polycondensate and anionic film-forming polymer to yield a hair composition with droplets having an average diameter of less than or equal to 80 μm . Thus, Malawer provides no motivation or guidance for one of ordinary skill in the art to pick and choose certain teachings of Mougin in order to render the instant claims obvious.

For at least the reasons provided above, the Examiner failed to establish a *prima facie* case of obviousness based on the combination of Mougin, Samain, Bhatt and Malawer.

III. CONCLUSION

In view of the foregoing amendment and remarks, Applicant respectfully requests reconsideration of this application and the timely allowance of the pending claims.

If there is any fee due in connection with the filing of this response, please charge the fee to Deposit Account No. 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

/Louis Troilo/

Dated: March 23, 2009

By: _____
Louis M. Troilo
Reg. No. 45,284